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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,046	06/29/2001	Peter O. Vale	60001.51USU1	9307

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MICROSOFT CORPORATION
C/O MERCHANT & GOULD, L.L.C.
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER
PARTON, KEVIN S

ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)	
Office Action Summary	09/895,046	VALE, PETER O.	
	Examiner	Art Unit	
	Kevin Parton	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-21* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____ .
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
        application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____ .
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____ .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-4 and 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by

Dickelman (USPN 6,529,187).

3.   Regarding claim 1, Dickelman (USPN 6,529,187) teaches a system for entering an

address into a web browser of a mobile device with means for:

      a. Receiving at least one character of text (column 2, lines 51-56; column 4,

          lines 45-47).

      b. Determining whether the at least one character of text is a single word

          (column 4, lines 45-47).

      c. If so, then displaying a list in the web browser with a list item wherein the list

          item comprises the at least one character of text with an automatic prefix

          added before the at least one character of text and an automatic suffix added

          after the at least one character of text (column 4, lines 45-47; column 5, lines

          55-60). Note that the claim allows for a list of one item which is shown in the

          reference.

4.   Regarding claim 2, Dickelman (USPN 6,529,187) teaches all the limitations as applied to
claim 1. He further teaches means wherein the automatic prefix is "www." (column 4, lines 45-
47).

5.   Regarding claim 3, Dickelman (USPN 6,529,187) teaches all the limitations as applied to
claim 2. He further teaches means wherein the automatic suffix is ".com" (column 4, lines 45-
47).

6.   Regarding claim 4, Dickelman (USPN 6,529,187) teaches all the limitations as applied to
claim 1. He further teaches means wherein the mobile device is a wireless telephone (column 3,
lines 13-16).

7.   Regarding claim 11, Dickelman (USPN 6,529,187) teaches all the limitations as applied
to claim 1. He further teaches means wherein the at least one character of text is received in
response to a user selecting keys on a keypad of a wireless phone (column 3, lines 12-15).

8.   Regarding claim 12, Dickelman (USPN 6,529,187) teaches all the limitations as applied
to claim 1. He further teaches means wherein the automatic prefix and the automatic suffix may
be modified to a desired prefix and a desired suffix (column 5, lines 61-65).

9.   Regarding claim 13, Dickelman (USPN 6,529,187) teaches all the limitations as applied
to claim 12. He further teaches means wherein the automatic prefix and automatic suffix are
modified by receiving input from a user requesting that the automatic prefix be set to a first
string and that the automatic suffix be set to a second string (column 5, lines 61-65).

10.   Regarding claim 14, Dickelman (USPN 6,529,187) teaches all the limitations as applied
to claim 13. He further teaches means wherein the automatic prefix and the automatic suffix are
stored in a registry (column 4, lines 45-47).

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

12.   Claims 5-10 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Dickelman (USPN 6,529,187) in view of Will (USPN 6,392,640).

13.   Regarding claim 5, although the system disclosed by Dickelman (USPN 6,529,187) (as

applied to claim 1) shows substantial features of the claimed invention, it fails to disclose means

for determining whether the at least one character of text matches any previous addresses entered

into the web browser; and if so, then displaying the possible matches as list items in the list.

Nonetheless, these features are well known in the art and it would have been an obvious

modification of the system disclosed by Dickelman (USPN 6,529,187), as evidenced by Will

(USPN 6,392,640).

In an analogous art, Will (USPN 6,392,640) discloses a system for entering data on a

mobile device with means for determining whether the at least one character of text matches any

previous addresses entered into the web browser (column 5, lines 22-23; abstract); and if so, then

displaying the possible matches as list items in the list (column 6, lines 55-58). Note that in the

reference, recently used addresses may be the type of words being searched.

Given the teaching of Will (USPN 6,392,640), a person having ordinary skill in the art

would have readily recognized the desirability and advantages of modifying Dickelman (USPN

6,529,187) by employing the determination of a word corresponding to the characters entered.

This benefits the system by increasing the ease with which a user can enter addresses into a mobile device.

14.   Regarding claim 6, although the system disclosed by Dickelman (USPN 6,529,187) (as applied to claim 5) shows substantial features of the claimed invention, it fails to disclose means wherein the step of determining whether the at least one character of text matches any previous addresses entered into the web browser comprises searching the addresses of previously viewed URLs in the browser's history, cache, or recently entered addresses for potential matches.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Dickelman (USPN 6,529,187), as evidenced by Will (USPN 6,392,640).

In an analogous art, Will (USPN 6,392,640) discloses a system for entering data on a mobile device with means for searching the addresses of previously viewed URLs in the browser's history, cache, or recently entered addresses for potential matches (abstract; column 5, lines 22-23; column 6, lines 55-58).

Given the teaching of Will (USPN 6,392,640), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Dickelman (USPN 6,529,187) by employing the searching of recently viewed addresses in creating the list. This benefits the system by presenting only items that are most likely to be of use to the user.

15.   Regarding claim 7, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 5. He further teaches means for:

    a. Determining whether the user is ready to navigate to the URL defined by the at least one character of text (figure 1; column 4, lines 59-63; column 6, lines 20-22).

    b. If so, the navigating the web browser to display a page defined by the at least one character of text (column 6, lines 20-22).

16.   Regarding claim 8, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 7. He further teaches means wherein the at least one character of text is displayed in an address field (column 4, lines 45-47).

17.   Regarding claim 9, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 7. He further teaches means for:

    a. Determining whether one of the list items in the list has been selected by the user (figure 1; column 4, lines 59-63; column 6, lines 20-22).

    b. If so, then navigating the web browser to display a page located at an address defined by the selected list item (column 6, lines 20-22).

18.   Regarding claim 10, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 9. He further teaches means wherein if one of the list items has not been selected by the user, then receiving another character of text (figure 1; column 4, lines 59-63; column 6, lines 20-22). Note that the user enters the address before choosing to navigate there.

19.   Regarding claim 15, Dickelman (USPN 6,529,187) teaches a system for text entry in an electronic device with means for:

    a. Receiving at least one character of text (column 2, lines 51-56; column 4, lines 45-47).

b. Determining whether the at least one character of text is a single word and if

so, then adding a prefix and a suffix to the at least one character of text to

form a combined address and displaying the combined address as an entry in a

selection list (column 4, lines 45-47; column 5, lines 55-60).

Although the system disclosed by Dickelman (USPN 6,529,187) shows substantial

features of the claimed invention, it fails to disclose means wherein the list is made up of a

plurality of addresses.

Nonetheless, these features are well known in the art and it would have been an obvious

modification of the system disclosed by Dickelman (USPN 6,529,187), as evidenced by Will

(USPN 6,392,640).

In an analogous art, Will (USPN 6,392,640) discloses a system for entering data on a

mobile device wherein the list is made up of a plurality of addresses (column 5, lines 22-23;

abstract).

Given the teaching of Will (USPN 6,392,640), a person having ordinary skill in the art

would have readily recognized the desirability and advantages of modifying Dickelman (USPN

6,529,187) by employing the use of a list of a plurality of addresses. This benefits the system by

allowing a user to see multiple addresses that may be of interest that are similar to the entered

character.

20.   Regarding claim 16, although the system disclosed by Dickelman (USPN 6,529,187) (as

applied to claim 15) shows substantial features of the claimed invention, it fails to disclose

means wherein the plurality of addresses comprises at least one address found by searching a

memory location in the electronic device and to find the at least one address with the at least one

character of text.

Nonetheless, these features are well known in the art and it would have been an obvious

modification of the system disclosed by Dickelman (USPN 6,529,187), as evidenced by Will

(USPN 6,392,640).

In an analogous art, Will (USPN 6,392,640) discloses a system for entering data on a

mobile device wherein the plurality of addresses comprises at least one address found by

searching a memory location in the electronic device and to find the at least one address with the

at least one character of text (abstract; column 5, lines 22-23; column 6, lines 55-58).

Given the teaching of Will (USPN 6,392,640), a person having ordinary skill in the art

would have readily recognized the desirability and advantages of modifying Dickelman (USPN

6,529,187) by employing the searching of recently viewed addresses in creating the list. This

benefits the system by presenting only items that are most likely to be of use to the user.

21.   Regarding claim 17, although the system disclosed by Dickelman (USPN 6,529,187) (as

applied to claim 16) shows substantial features of the claimed invention, it fails to disclose

specifically means wherein the memory location is a history folder in a web browser program

module of the electronic device.

Nonetheless, these features are well known in the art and it would have been an obvious

modification of the system disclosed by Dickelman (USPN 6,529,187).

A person having ordinary skill in the art would have readily recognized the desirability

and advantages of modifying Dickelman (USPN 6,529,187) by searching the web browser

history for recently viewed addresses. This benefits the system because the history folder is a

common place where different types of web browsers store the web pages of recent interest to the user.

22.   Regarding claim 18, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 15. He further teaches means wherein the selection list is a selection list in a web browser program module and the combined address and the plurality of addresses comprise URLs for Internet addresses (column 4, lines 45-47).

23.   Regarding claim 19, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 18. He further teaches means for receiving an input selecting the at least one character of text and navigating the web browser program module to view a web page located at an address defined by the at least one character of text (column 6, lines 20-22).

24.   Regarding claim 20, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 18. He further teaches means for receiving an input selecting the combined address and navigating the web browser program module to view a web page located at the combined address (column 6, lines 20-22).

25.   Regarding claim 21, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 18. He further teaches means for receiving an input selecting an address and navigating the web browser program module to view a web page located at the address (column 6, lines 20-22).

        Although the system disclosed by Dickelman (USPN 6,529,187) shows substantial features of the claimed invention, it fails to disclose means wherein the address is selected from a plurality of addresses.

Nonetheless, these features are well known in the art and it would have been an obvious

modification of the system disclosed by Dickelman (USPN 6,529,187), as evidenced by Will

(USPN 6,392,640).

In an analogous art, Will (USPN 6,392,640) discloses a system for entering data on a

mobile device wherein the address is selected from a plurality of addresses (column 5, lines 22-

23; abstract).

Given the teaching of Will (USPN 6,392,640), a person having ordinary skill in the art

would have readily recognized the desirability and advantages of modifying Dickelman (USPN

6,529,187) by employing the selection from a plurality of addresses. This benefits the system by

allowing a user to see multiple addresses that may be of interest that are similar to the entered

character.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Kevin Parton whose telephone number is (703)306-0543. The

examiner can normally be reached on M-F 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Glenton Burgess can be reached on (703)305-4792. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.
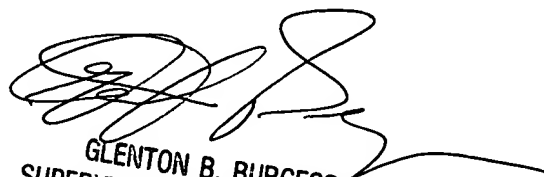
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin Parton
Examiner
Art Unit 2153

ksp

GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100